

From the INTERNATIONAL SEARCHING AUTHORITY

To:
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PCT

SEP 2002
Received
Chiron Corporation
Intellectual Property

INVITATION TO PAY ADDITIONAL FEES

(PCT Article 17(3)(a) and Rule 40.1)

RECEIVED

DEC 19 2002

TECH CENTER 1600/2900

Applicant's or agent's file reference

PP-15990-003

International application No.

PCT/US 01/25840

Applicant

CHIRON CORPORATION

Date of mailing
(day/month/year)

09/09/2002

PAYMENT DUE

within 45 ~~xxx~~ days/days
from the above date of mailing

International filing date
(day/month/year)

16/08/2001

1. This International Searching Authority

- (i) considers that there are 6008 (number of) inventions claimed in the international application covered by the claims indicated ~~xxx~~ on the extra sheet:

and it considers that the international application does not comply with the requirements of unity of invention (Rules 13.1, 13.2 and 13.3) for the reasons indicated ~~xxx~~ on the extra sheet:

DOCKETED on/by 9/18/02, mns
Atty. ASD PA
File # 15990.003
Due Date 16/24/02 Ext ASD
Final Date 16/24/02

- (ii) ☒ has carried out a partial international search (see Annex) ☐ will establish the international search report on those parts of the international application which relate to the invention first mentioned in claims Nos.:
1-23 (all partially)

- (iii) will establish the international search report on the other parts of the international application only if, and to the extent to which, additional fees are paid

2. The applicant is hereby invited, within the time limit indicated above, to pay the amount indicated below:

EUR 945,00 x 6007 = EUR 5.676.615,00
Fee per additional invention number of additional inventions total amount of additional fees

Or, _____ x _____ = _____

The applicant is informed that, according to Rule 40.2(c), the payment of any additional fee may be made under protest, i.e., a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive.

3. ☒ Claim(s) Nos. further info have been found to be unsearchable under Article 17(2)(b) because of defects under Article 17(2)(a) and therefore have not been included with any invention.

Name and mailing address of the International Searching Authority

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Authorized officer

Barbara Klaver

FURTHER INFORMATION CONTINUED FROM PCT/ISA/ 206

Continuation of Box 3.

Although claim 23 is directed to a method of treatment of the human/animal body, the search has been carried out and based on the alleged effects of the compound/composition.

This International Searching Authority found multiple (groups of) inventions in this international application, as follows:

1. Claims: invention 1: claims 1-23 all partially

Polynucleotide having a sequence as in SEQ ID NO:1.
Polynucleotides overlapping with said SEQ ID NO:1, having a sequence as in SEQ ID NO:2957 and 5175. Products and methods related thereto.

2. Claims: inventions 2-6008: claims 1-23 all partially,
where applicable

As invention 1 but respectively relating to SEQ ID NO:2-6010, wherein invention 2 relates to SEQ ID NO:2, inventions 3-2956 relate to SEQ ID NO:3-2956, invention 2957 relates to SEQ ID NO:2958, inventions 2958-5173 relate to SEQ ID NO:2959-5174, invention 5174 relates to SEQ ID NO:5176, inventions 5175-6008 relate to SEQ ID NO:5177-6010.

For the sake of conciseness, the first subject-matter is explicitly defined, the other subject-matters are defined by analogy thereto.

The inventions as defined above relate to a number of human polynucleotides, and to their potential application in cancer diagnostic and therapy.

Document WO 99/64594 discloses polynucleotides differentially regulated in prostate cancer and their potential application in diagnostic and therapy.

In view of this prior art, the problem underlying the present application is the provision of further human polynucleotides potentially related to cancer.

The solution as disclosed and claimed in the present application can be summarised as the provision of 6010 human polynucleotides.

Due to the fact that human polynucleotides and their potential application in cancer diagnostic and therapy are already known from the prior art, due to the difference in the primary structure of the polynucleotides of present invention, and due to the fact that no other technical feature can be distinguished which, in the light of the prior art could be regarded as special, common technical feature, the ISA is of the opinion that there is no single inventive concept underlying the plurality of claimed inventions of the present application in the sense of rule 13.2 PCT.

Consequently there is lack of unity and the different inventions, not belonging to a common inventive concept, are formulated as the different subjects on the communication pursuant to Article 17(3)(a) PCT.

1. The present communication is an Annex to the invitation to pay additional fees (Form PCT/ISA/206). It shows the results of the international search established on the parts of the international application which relate to the invention first mentioned in claims Nos.:
2. This communication is not the international search report which will be established according to Article 18 and Rule 43.
see 'Invitation to pay additional fees'
3. If the applicant does not pay any additional search fees, the information appearing in this communication will be considered as the result of the international search and will be included as such in the international search report.
4. If the applicant pays additional fees, the international search report will contain both the information appearing in this communication and the results of the international search on other parts of the international application for which such fees will have been paid.

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category °	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	<p>DATABASE EMBL 'Online! 6 July 2000 (2000-07-06) BIRREN B. ET AL.: "Homo sapiens chromosome 2, clone RP11-265B3" Database accession no. AC073025 XP002208136 nucleotides 121240-121850 the whole document</p>	1-12, 14, 15, 20-22
X	<p>DATABASE EMBL 'Online! 9 June 2000 (2000-06-09) BIRREN B. ET AL.: "Homo sapiens, clone RP11-12010" Database accession no. AC068959 XP002208137 nucleotides 99383-99993 the whole document</p>	1-12, 14, 15, 20-22
A	<p>WO 99 64594 A (CHIRON (US) ASTEL CARROLL ENDEGE FORD MONAHAN SCHLEGEL STEINMANN ZHANG) 16 December 1999 (1999-12-16)</p>	

☐ Further documents are listed in the continuation of box C.

☒ Patent family members are listed in annex.

° Special categories of cited documents :

- "A" document defining the general state of the art which is not considered to be of particular relevance
- "E" earlier document but published on or after the international filing date
- "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
- "O" document referring to an oral disclosure, use, exhibition or other means
- "P" document published prior to the international filing date but later than the priority date claimed

"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention

"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.

"&" document member of the same patent family

Patent document cited in search report		Publication date	Patent fam member(s)	Publication date
WO 9964594	A	16-12-1999	AU 4435899 A	30-12-1999
			EP 1086218 A2	28-03-2001
			JP 2002517244 T	18-06-2002
			WO 9964594 A2	16-12-1999
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